

Attorney Docket No. P66717US0
Serial No.: 09/857,182

Claims 8-10, 13, and 14 were rejected under 35 USC 103(a) for alleged obviousness based on the combined teachings of U.S. Patent No. 5,556,689 (Kratel) and U.S. Patent No. 4,783,365 (Sklarski). Claims 11 and 12 were rejected for alleged obviousness under 35 USC 103(a) based on the combined teachings of Kratel, Sklarski, and U.S. Patent No. 4,647,449 (Takahashi). Claim 15 was rejected for alleged obviousness under 35 USC 103(a) based on the combined teachings of Kratel, Sklarski, and U.S. Patent No. 4,381,327 (Briers). Claim 16 was rejected for alleged obviousness under 35 USC 103(a) based on the combined teachings of Kratel, Sklarski, and U.S. Patent No. 5,989,371 (Nishimoto). Claim 17 was rejected for alleged obviousness under 35 USC 103(a) based on the combined teachings of Kratel, Sklarski, and U.S. Patent No. 5,741,608 (Kojima). Reconsideration of the rejections is requested.

The statement of rejection correctly states that Kratel fails to disclose cover sheets of prefabricated mica. This deficiency is overcome, according to the statement of rejection, by Sklarski. For the reasons of record set forth in Applicants' previous reply, the mica-containing sheet of Sklarski is unsuitable as a cover for a heat insulation body. As explained in the specification (page 3, ¶5), the heat insulation body of the invention should not include, inter alia, organic components, which could result in the release of toxic gasses during processing. This had been pointed out in Applicants' previous reply (organic components "would destabilize the product upon heating and could also release toxic gases").

Attorney Docket No. P66717US0
Serial No.: 09/857,182

Accordingly, in order to more clearly reflect the foregoing aspect of the invention in the claims, the claims presented, hereby, expressly exclude "organic components in a substantial amount."

As can be seen from the Sklarski document, the disclosed sheets contain huge amounts of organic components (polysiloxane binder, organic titan derivatives, organic zinc salts). These organic components are innocuous in the context of use according to Sklarski, but not in the context of the invention presently claimed. Sklarski uses the material as an *electrical* insulator, not a *thermal* insulator. Therefore, assuming arguendo there was a motivation for one skilled in the art to combine Kratel with Sklarski, the combination would not have effected the presently claimed invention.

None of the other secondary references cited in the rejections of record under §103(a) cures this fatal deficiency in the combined teachings of Kratel and Sklarski.

Takashi relates to a calcium silicate body. It is silent with respect to mica sheet.

Briere discloses mica foil lamination. It comprises using pressure sensitive adhesive as a bonding material, this comprises organic materials. Furthermore, a mica layer is combined with the metal foil. Therefore, this document does not disclose that a cover of prefabricated mica can be used to improve the mechanical properties and reduce the heat transfer of heat insulation bodies.

Nishimoto is cited with respect to claim 16 (heat sealed with a sheet). It does not cure the deficiency of the primary reference with respect to a heat insulation body free of organic compounds.

Kojima discloses a multilayer type non-aqueous electrolyte secondary cell for power supplies and the like. It is totally different from the heat insulating body of the present invention. A number

Attorney Docket No. P66717US0
Serial No.: 09/857,182

of sheet materials are disclosed, both of the inorganic or organic type. From this document, one does not get any motivation to use such a sheet for a heat insulation body.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be found in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since all of the limitations in the present claims are not found in any of the references relied on in the rejections of record under §103(a), taking the references alone or as combined, the rejections of record under §103(a) are not applicable against the present claims, i.e., the references relied on would not support a *prima facie* case of obviousness against the present claims.

Additionally, allegations made in the "Response to Arguments" with respect to claim 14 are poorly taken and continued reliance on *In re Boesch*, 205 USPQ 215 (CCPA 1980) to reject the claim is misplaced. The rejection under §103(a) cannot be based on the allegation that a claimed parameter is an obvious *optimization* of a prior art parameter involving "only routine skill in the art" (Office Action page 4). "That which is within the capabilities of one skilled in the art is not synonymous with obviousness [citations omitted]." *Ex parte Levensgood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993). "We have previously rejected the argument that undirected skill of one in the pertinent art is an adequate substitute for statutory prior art [citation omitted]." *In re Kratz*, 201 USPQ 71, 76 (CCPA 1979). When obviousness of a claim limitation is grounded on its allegedly being "old and well known in the art . . . as a means of optimization which is highly

Attorney Docket No. P66717US0
Serial No.: 09/857,182

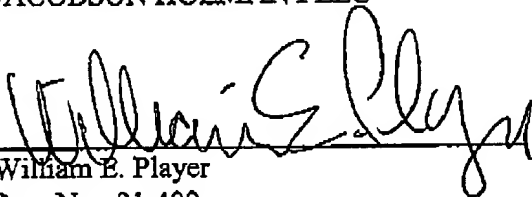
desirable," the "ground of rejection is simply inadequate on its face . . . because the cited references do not support each limitation of [the] claim." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). An argument by the PTO is "not prior art." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). *Boesch, supra*, simply does not support the position taken in the statement of rejection.

Favorable action is requested.

Respectfully submitted,

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